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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,653	06/22/2001	James E. Fox	018760.23	7190
21878	7590	12/02/2005	EXAMINER	
KENNEDY COVINGTON LOBDELL & HICKMAN, LLP 214 N. TRYON STREET HEARST TOWER, 47TH FLOOR CHARLOTTE, NC 28202			FAISON, VERONICA F	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/887,653	<b>Applicant(s)</b> FOX ET AL.	
	<b>Examiner</b> Veronica F. Faison	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10-21-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-16, 20, 21 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-16, 20, 21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Preamble*

The preamble limitation "for drop on demand inkjet printing" is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 USPQ 6411.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 10-12, 14-16, 20, 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thakkar (US Patent 5,512,089).

Thakkar teaches an ink jet ink composition comprising a liquid vehicle, a pigment and a base (abstract and col. 2 lines 30-35). The reference further teaches that polypropylene glycol has a molecular weight of 425 and a surfactant such as Surfynol TGE (col. 3 lines 10-15). See example 2 and claims 1-17. In example 2, the amount of carbon black in the carbon dispersion is 21%, which converts to 2.9% carbon black.

Thakkar fails to specifically exemplify the claimed ratio of pigment to polypropylene glycol of at least 1:1.4 to about 1:2.5 as claimed by applicant.

However, it would have been obvious to one of ordinary skill in the art to use the specific ratio of pigment to polypropylene glycol as claimed by applicant as Thakkar also

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discloses the use of pigment and polypropylene glycol in overlapping ranges but shows no example incorporating them in the claimed ratio.

A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skill in the art would have expected them to have the same properties *Titanium Metals Corp of America v. Banner*, 778 F.2d 775, 227 USPQ 773.

Claims 1-7, 10-16, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1 114 850.

EP 1 114 850 teaches an ink composition comprising a colorant, glycerin, a glycol compound and water (abstract and page 3 lines 9-10). The colorant is a pigment that has been rendered dispersible and/or dissolved in water without a surfactant or a dispersant (page 3 lines 14-16). The glycol compound is present in the amount of 1 to 30 percent by weight and has a molecular weight is about 130 to 3,000 such as polypropylene glycol (page 4 line 54-page 5 line 36). Water is the main solvent in the ink composition however addition solvents such as 2-pyrrolidone may be present and the ink further comprise pH adjustors, antioxidants and ultraviolet absorbers, preservatives and antimold (page 5 line 40-page 6 line 33). See Comparative Example W3 and W4. In example W3 and W4, the amount of pigment in the dispersion is 10%, which converts to 4.5% pigment. EP 1 114 850 fails to specifically exemplify the claimed ratio of pigment to polypropylene glycol of at least 1:1.4 to about 1:2.5 as claimed by applicant.

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However, it would have been obvious to one of ordinary skill in the art to use the specific ratio of pigment to polypropylene glycol as claimed by applicant as EP 1 114 850 also discloses the use of pigment and polypropylene glycol in overlapping ranges but shows no example incorporating them in the claimed ratio, absence tangible evidence to the contrary.

Nonpreferred embodiments can be indicative of obviousness. *Merck & Co. v. Biocraft Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Lamberti* 192 USPQ 278 (CCPA 1976); *In re Kohler* 177 USPQ 399 (CCPA 1973); *In re Mills* 176 USPQ 196 (CCPA 1972); *In re Bozek* 163 USPQ 545 (CCPA 1969); *In re Meinhardt* 157 USPQ 270 (CCPA 1968); *In re Boe* 148 USPQ 507 (CCPA 1976); *In re Nehrenberg* 126 USPQ 383.

A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982).

### ***Response to Arguments***

Applicant's arguments filed 10-21-05 have been fully considered but they are not persuasive.

In response to applicant's argument that Thakkar is directed to pigmented ink for use in continuous inkjet printers, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative

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difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Therefore the rejection over Thakkar has been maintained.

Applicant also argues that the ink composition of the present invention does not contain glycerin but does comprise a particular glycol, namely polypropylene glycol. However, Applicant claims recite the term "comprising" which leaves the claim open for the inclusion of unspecified ingredients event in major amounts. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). When Applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of" Applicant has the burden of showing the basic and novel characteristics of his composition – i.e. showing that the introduction of these components would materially change the characteristics of Applicant's composition. *In re De Lajarte*, 337 F 2d 870, 143 USPQ 256 (CCPA 1964). Therefore the rejection of EP 1 114 850 has been maintained absence tangible evidence to the contrary.

### ***Conclusion***

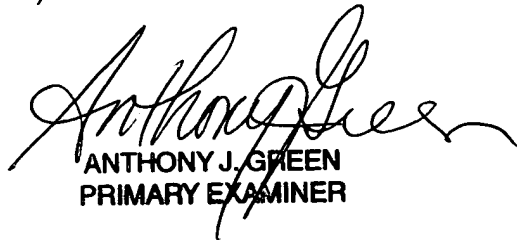
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VFF  
11-25-05



ANTHONY J. GREEN  
PRIMARY EXAMINER